

REMARKS

In the Office Action mailed August 10, 2005, the Examiner rejected claims 21-40. Applicants traverse these rejections. Applicants have also added new claim 41.

I. Claim Rejections under 35 USC 103

The Office Action rejected claims 21-40 as being obvious in view of various combinations of the following references: Noda et al. (4631976); Steuart et al. (1581884); Masubuchi (6,472,442); Hasegawa et al. (5,550,190); Rico (4981737); Kurata et al. (4547655); Bonn et al. (6441344); Nagai (6,808,825); Plummer et al. (6,284,809); Sugiyama et al. (6414270); Haushultz et al. (5714738); Haag (6093908). Applicants traverse these rejections on several grounds as discussed below.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembicza, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In the case of In re Rouffet (CA FC) 47 USPQ2d 1453, 1457-1458 (July 1998), the court wrote:

Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. Section 103(a). This legal construct is akin to the "reasonable person" used as a reference in negligence determinations. The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. See In re Carlson, 983 F.2d 1032, 1038, 25 USPQ2d 1207, 1211 (Fed. Cir. 1993).

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Claims 21-23

In rejecting claims 21-23, the Office Action combines Noda et al. with Steuart et al., Masubuchi and Hasegawa et al. This combination is improper for at least three reasons. First, the Office Action provides no proper motivation for combining Steuart et al., Masubuchi and Hasegawa et al. with Noda. Second, the Office Action admits that the references used to assert obviousness do not actually combine to form the invention of claims 21-23. Third, Masubuchi and Hasegawa et al. are from non-analogous arts and the skilled artisan would be very unlikely to look to Masubuchi and Hasegawa et al. for subject matter to modify Noda et al. and Steuart et al.

The Office action suggests that it,

would have been obvious ... to modify Noda's invention to include a cushion as taught by Masubuchi and a separator as taught by Hasegawa in order to permit elongation of the cushion and the separator at least 50%, and the heater as taught by Steuart that can inherently elongate. While Steuart does not explicitly teach 15% elongation, one of ordinary skill in the art would have been able to arrive at the % without undue experimentation.

This statement provides no motivation in the prior art or in any principle known to the skilled artisan, much less any specific motivation, for combining Masubuchi and Hasegawa with Steuart and Noda. Rather, the Office Action merely rewords the properties recited in claim 21 and suggests that the use of materials from Masubuchi and Hasegawa et al. would provide those properties. Such rewording provides no particular reasoning or motivation as to why the skilled artisan would choose Masubuchi and Hasegawa et al. as references to find materials for the heaters disclosed in Noda and Steuart, particularly where, as further discussed below, the disclosures of Masubuchi and Hasegawa et al. are not related to heaters. Applicants contend that the Office Action fails to assert a *prima facie* case of obviousness against

claims 21-23 of the present application for failure to assert a proper motivation for combining the references used to reject claims 21-23.

In addition to the lack of motivation, the Office Action admits that Steuart does not suggest 15% elongation of a heater, but then suggests that the skilled artisan could arrive at such % without “undue experimentation.” Applicants contend that this statement illustrates how the Office Action has failed to assert a *prima facie* case of obviousness against claims 21-23. In particular, the Office Action has admitted that the language recited in claims 21 is not shown in the prior art, but then tries to assert obviousness on the notion that the skilled artisan could have achieved that which is recited in the claims without undue experimentation. However, undue experimentation is not the test of obviousness, rather, obviousness requires a showing of the language of the claim in the prior art or in the knowledge of the skilled artisan and a motivation to combine. The suggestion of undue experimentation illustrates that the Office Action has attempted to piece together the invention of claim 21 with the use of impermissible hindsight.

In addition to the above, the combination of Masubuchi and Hasegawa et al. with Noda et al. and Steuart et al. is improper because Musubuchi and Hasegawa et al are from non-analogous arts relative to Noda et al. and Steuart et al and the skilled artisan would be very unlikely to look to Masubuchi and Hasegawa et al. for subject matter to modify Noda et al. and Steuart et al. In particular, Masubuchi, as suggested by the Office Action, only, “discloses a steering wheel having a rim part 14 covered by polyurethane elastomer that can elongate up to 800%...” The Office Action then attempts to suggest the use of the material of Masubuchi for a heater, however, the disclosure of Masubuchi does not disclose and is unrelated to heaters or heating. Moreover, the skilled artisan would be unlikely to look to the disclosure of Masubuchi for a material to use for a heater since the considerations for forming a covering for a rim part such as that of Masubuchi are quite different from the consideration involved in selecting materials for heaters since the processing and/or formation of the covering of Masubuchi would be quite different from the processing and/or formation of a heater. As such, Applicants contend that the obviousness rejection of claims 21-23 should be withdrawn.

Moreover, for claim 23, the Office Action ignores the language reading that, "the cushion is formed of a compressed polyurethane foam material." As such, the Office Action again fails to assert a prima facie case of obviousness against claim 23 of the present application and the rejection of claim 23 should be withdrawn.

Claim 24

Applicants contend that the obviousness rejection of claim 24 is improper because, in addition to the reasons presented for claims 21-23, the Office Action has not shown that the language of claim 24 is in the prior art or within the knowledge generally available to the skilled artisan. The Office Action suggests that since Kurata show two zones, "It would have been obvious...to use distinct zones as taught by Kurata and increase their number to three zones for redundancy in case one or two zones are damaged." However, Kurata does not even show three zones as recited in claim 24 and the statement in the Office Action is merely supposition that is not based upon evidence of prior art or knowledge of the skilled artisan and shows that the Office Action is attempting to reconstruct claim 24 based upon impermissible hindsight. Applicants request that the rejection of claim 24 be withdrawn.

Claim 25

Applicants traverse the rejection of claim 25 on the ground that the Office Action fails to assert a Prima Facie case of obviousness against claim 25 and the Office Action uses a reference from a non-analogous art. In rejection claim 25, the Office Action suggests that, "It would have been obvious...to include strands of heating wire...in a composition as taught by Nagai as an obvious functional equivalent." However, the Office Action provides no specific motivation for using the composition of Nagai and the Office Action provides no evidence that the composition of Nagai is an "obvious functional equivalent" that the skilled artisan would use. Moreover, the skilled artisan would be quite unlikely to look to Nagai for a composition for heater wires since Nagai is directed to printed wiring boards (see Abstract and Background of Invention), which is a non-analogous art to heated handles and heated steering wheels and heated handles and steering wheels typically require different

design considerations relative to printed wiring boards. Applicants assert that the obviousness rejection of claim 25 should be withdrawn.

Claims 27-28

Applicants traverse the rejection of claims 27-28 on the ground that the Office Action fails to assert a Prima Facie case of obviousness against claims 27-28 and the Office Action uses a reference from a non-analogous art. In particular, the Office Action fails to show a conductor that, "is folded over on itself and twisted at a connection of the heater" as recited in claim 28. Thus, the Office Action fails to assert a prima facie case of obviousness since it does not show all language of claim 28 in the prior art or the knowledge of the skilled artisan. The Office Action, for claim 27, suggests that it would have been obvious to use a material having a "thermal conductivity range as taught by Plummer as an obvious functional equivalent..." However, the Office Action provides no specific motivation for using the material of Plummer with the other references cited and provides no evidence that the material of Plummer is an "obvious functional equivalent" that the skilled artisan would be motivated to use. Moreover, the skilled artisan would be quite unlikely to look to Plummer for a material for the cushion or separator of a heated handle or heated steering wheel since Plummer is directed to foam for insulating oil pipelines (see Background of Invention), which is a non-analogous art to heated handles and heated steering wheels and heated handles and heated steering wheels require vastly different design considerations relative to oil pipelines. Applicants assert that the obviousness rejection of claim 27 and 28 should be withdrawn.

Claims 29-30

Applicants traverse the rejection of claims 29-30 because the Office Action incorrectly cites Haag as disclosing, at Col. 4, Lines 40-50, "the cushion ... laminated to the separator with an adhesive" and the adhesive ... provided as a monolayer adhesive film" as recited in claims 29-30. However, Applicants review of Col. 4, Lines 40-50 of Haag has found no indication that Haag discloses that which is recited in the aforementioned language. As such, Applicants assert that the Office Action fails to assert a prima facie case of obviousness against claims 29-30.

Claims 31-40

Applicants traverse the rejections of claims 31-40 for all the same reasons as indicated above where such reasons apply. Applicants further traverse the rejections of claims 31-40 for additional reasons below.

Claims 31 and 37

Applicants additionally traverse claims 31 and 37 on the grounds that the Office Action ignored language of claims 31 and 37 thereby failing to establish a prima facie case of obviousness against those claims. In particular, both claim 31 and claim 37 substantially recite a core of a steering wheel that includes a core that is formed of, "a rigid member that is at least partially covered with a polymeric material, the core having a substantially circular configuration". Applicants find no mention of this language by the Office Action. Further, Applicants contend that recognition of this language by the Office Action would force reconsideration of the manner in which components were identified in Noda for the rejection of claim 21. Without consideration of this language, the Office Action has failed to establish a prima facie case of obviousness against claims 31 and 37 and their dependents.

For all the reasons above, Applicants request that the obviousness rejections of claim 21-40 be withdrawn.

Moreover, Applicant points out that it would likely be improper to present a final rejection of claims 21-40 on a grounds alternative to that already presented since applicants have not amended claims 21-40 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

New Claim

Applicants contend that new claim 41 is patentable over the references of record.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

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PETITION FOR EXTENSION OF TIME

Applicants respectfully request and petition an appropriate extension of time to respond to the outstanding Office Action, of at least one (1) month. Enclosed is a check in the amount of \$60.00. For any deficiencies, please charge Deposit Account No. 50-1097 for any fee which may be due is hereby given.

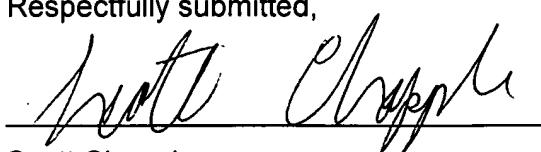
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

Dated: 5 October, 2005



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